Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG GUNZEL and PETER BACHMAN

Appeal No. 2000-0979
Application 08/767,734[1]

ON BRIEF

Before LEE, GARDNER-LANE and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-5, 8, 11 and 14-17.

A. Findings of Fact

1. The appellants state that the real party in interest is U.S. Philips Corporation. (Brief at 1).

2. The application on appeal contains claims 1-17.

3. The examiner has indicated that claims 6, 7, 9, 10,

[1] Application for patent filed December 16, 1996.

12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. (Paper 8 at 5).

4. Claims 7 and 9 are objected to due to certain informalities. (Answer at 3).

5. Claims 1-5, 8, 11, 14, 15 and 17 have been rejected as being unpatentable under 35 U.S.C. § 102(e) as being anticipated by Inoue et al. (Inoue), U.S. Patent 5,623,303, issued April 22, 1997, based on application 08/394,760, filed February 27, 1995.

6. Claim 16 has been rejected as being unpatentable under 35 U.S.C. § 103 over Inoue in view of Takagi, U.S. Patent 5,699,144, issued December 16, 1997, based on application 08/434,845, filed May 4, 1995.

The invention

7. The disclosed invention pertains to a scanner with a means for converting contents of a film frame into a video signal, means for inserting a scaling signal into the video signal and means for processing the video signal.

8. Independent claim 1 is representative and is as follows:

A scanner comprising:

means for converting contents of a film frame into a video signal,

means for post-processing the video signal, and

means for inserting a scaling signal into the video signal before post-processing the video signal.

B. Discussion

The examiner has objected to claims 7 and 9 because of certain informalities. The Board has jurisdiction to decide issues involving claims that are finally or twice rejected. Claims that are objected to are not reviewable by the Board. Therefore, we do not address the examiner's objections to claim 7 and claim 9.

The rejections of the claims on appeal cannot be sustained. A reversal of the rejection on appeal should not be construed as an affirmative indication that the applicants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles

of inherency, each and every element of the claimed invention. In re Spada, 911 F.2d 705, 707, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The examiner finally rejected claims 1-5, 8, 11, 14, 15 and 17 as being anticipated by Inoue. Independent claims 1, 15 and 16 includes "means for inserting a scaling signal into the video signal before post-processing the video signal." In In re Donaldson Co., 16 F.3d 1195, 1189, 29 USPQ2d 1850, 1845 (Fed. Cir. 1994) (in banc), the court of Appeals for the Federal Circuit stated that:

> Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Prior to identifying structures, materials, and acts described in the specification, which correspond to a particular means, however, the examiner should first determine if the recited function is even performed in the prior art reference. Here, the issue is whether the prior art discloses "inserting a scaling signal into the video signal" as is recited in independent claims 1, 15 and 16.

Although extraneous limitations should not be read into

the claims from the specification, E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988), claim limitations are always properly interpreted in light of the specification and prosecution history. See, e.g., Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985). Here, we look to the specification to interpret the functional recitation of "inserting a scaling signal into the video signal."

Applicants' specification states the following:

> For inserting a scaling signal SKS into the video signal according to the invention, either an analog inserter circuit 7 is arranged in the analog signal branch before the A/D converter 6, or a multiplexer 8 is provided in the digital signal branch after the A/D converter 6. Both the inserter circuit and the multiplexer 8 may be controlled by a pulse shaper 9 in such a way that the scaling signal SKS is written in a test line of the video signal. The pulse shaper 9 counts the horizontal frequency pulses of the video signal and then controls either a pulse generator incorporated in the inserter circuit 7 or pulse generator 11 which applies the scaling signal SKS to the multiplexer 8, so that, for example, in the 625 line standard, the video signal is transmitted from the A/D converter 6 during 624 lines and the scaling signal SKS is transmitted from the pulse generator 11 during one line. (Specification, 2-3). (Emphasis added).

Thus, the scaling signal is inserted into the original video signal when written in a test line of the video signal.

The original video signal and the scaling signal coexist. The scaling signal does not change or affect the original video signal.

It is the examiner's position that Inoue's automatic exposure/white balance (AE/AWB) arithmetic circuit 42, along with elements 25-30 provide a means for inserting a scaling signal into the video signal. (Answer at 4). The examiner states the following:

> [E]lement 42 of Inoue et al, by calculating exposure control values, the gain of the amplifier 25 and the white balance correction value used during the reproduction based on the exposure data, provides the same scaling signal that is inserted into a video signal as claimed (see Figure 1, and columns 13-15 and 17 of Inoue et al). (Answer at 7).

The examiner has failed to demonstrate that elements 42 and 25-30 of Inoue insert a scaling signal into the video signal as claimed. Inoue describes the AE/AWB arithmetic circuit 42 as controlling iris driver 40 and CCD driver 41, and sending gain AG and WB correction values to amplifier 25 and WB circuit 26 to set the gains of the amplifier 25 and the WB circuit 26. (Inoue, column 18, lines 4-12).

The signals coming from the AE/AWB arithmetic circuit 42 control the gains and drivers of other circuits. Controlling

a video signal with another signal is not the same as inserting a signal into a video signal. The former changes or alters the video signal (e.g. increases the gain of the signal), whereas the latter does not.

Elements 25-30 further process the video signal as follows:

> A correlative double sampling (CDS) circuit 24, an amplifier 25, a white balance (WB) circuit 26, an analog-to-digital (A/D) converter unit 27 and ... correction circuit unit 28 constitute an image signal processing circuit for applying specified signal processing to the respective color image signals of R, G, B output from the CCD line sensor 23. (Inoue, column 13, lines 32-38).

Element 29 stores the processed image data R, G, B from circuits 24-28. (Inoue, column 15, lines 33-37). Element 30 is a color difference matrix that converts data from memory 29 into a picked up image by further processing and refining the video data. (Inoue, column 16, lines 26-28). Thus, the signals that emanate from elements 25-30 affect or change the video signal and are not signals that are inserted into the video signal as claimed.

The examiner has failed to provide sufficient evidence to demonstrate that Inoue teaches inserting a signal into a video signal as claimed.

Based on the record before us, the examiner has failed to establish that Inoue discloses, either expressly or under the principles of inherency, each and every element of the claimed invention.

Accordingly, we will reverse the decision of the examiner rejecting claims 1-5, 8, 11, 14, 15 and 17 under 35 U.S.C. § 102(e) as being anticipated by Inoue.

As applied by the examiner, Takagi does not make up for the deficiencies of Inoue reference. Accordingly, we do not sustain the rejection of claim 16 over Inoue in view of Takagi.

C. Decision

The examiner's rejection of claims 1-5, 8, 11, 14, 15 and 17 as being unpatentable under 35 U.S.C. § 102(e) as being anticipated by Inoue is reversed.

The examiner's rejection of claim 16 as being unpatentable under 35 U.S.C. § 103 over Inoue in view of Takagi is reversed.

REVERSED

JAMESON LEE Administrative Patent Judge	
SALLY GARDNER-LANE Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge	

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